

seen that the hyaluronic acid is used as a gel. This gel-like consistency is important since the composition is applied at the site of the bone fracture or defect and must persist at that site for a sufficient period of time as set forth in the specification and in the present claims. In order to persist the site to be effective as claimed, the composition must have a sufficient viscosity and biodegradability to achieve that purpose, as set forth in the claims. It is not seen where Miyoshi discloses these features. One cannot determine the molecular weight of the sodium hyaluronate that is used by Miyoshi. Moreover, Miyoshi's composition described in the abstract contains 0.5% by weight of sodium hyaluronate in 100mL of saline at pH 7.1. This would imply that the composition is a solution. The suggestion that it is a solution is further supported by the statement that the preparation of Miyoshi is effective for treating virus infections, aging, wounds, inflammations and bone diseases. This suggested application is typically achieved by introducing the composition into the bloodstream, such as by intramuscular injection, or oral ingestion. In any case, a solution could not persist at a bone defect since the solution would immediately dissipate into the bloodstream, musculature, or other parts of the body away from the site. Accordingly, it is not seen where Miyoshi's composition should inherently possess the same properties as the claimed composition and indeed from the above discussion, it would appear that Miyoshi's compositions do not have these properties. If the examiner continues to take the position that Miyoshi's composition inherently possesses the same properties as Applicant's claimed compositions, it is respectfully requested that the examiner point out where this is supported.

In view of the above comments, it is requested that this rejection be withdrawn.

Claim 18 is rejected under 35 U.S.C. 103(a) as unpatentable over Miyoshi. This rejection is respectfully traversed. The examiner states that the use of compositions containing the same components, but different viscosities, depends on factors such as the severity of bone disease in an individual that is being treated. This point is respectfully traversed. Nowhere that Applicant can find in the English disclosure of Miyoshi is viscosity or any consideration regarding the severity of bone disease disclosed. As discussed above, it appears to Applicant that Miyoshi is directed to solutions and furthermore, that these solutions can be generally used for the treatment of multiple conditions such as virus infection, aging, wounds, inflammations and bone diseases. There is no statement in the English portions of Miyoshi that the composition varies either according to the particular condition that is being treated (such as, not a bone disease) or that viscosity is a consideration even when treating bone diseases. Accordingly, it is submitted that it would have

been unobvious to one of ordinary skill in the art to even apply Miyoshi's compositions directly to a bone defect in order to treat a bone disease, or to even modify the composition in any manner other than to use it as a solution. The English portion of Miyoshi does not even suggest that a different form of the composition should be used for treating bone disease as compared to, for example, treating a virus infection or aging.

It is therefore submitted that claim 18 is unobvious over Miyoshi and withdrawal of this rejection is respectfully requested.

Applicant gratefully acknowledges the indication of allowance of the subject matter of claims 21 and 22.

For the foregoing reasons it is submitted in the present application is in condition for allowance.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call Applicants' undersigned attorney at (510) 663-1100.

Please apply any other charges or credits to deposit account number 50-388 (Order No. DEYP003D1C1).

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Respectfully submitted,  
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